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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,876	11/18/2003	Hideto Matsumoto	116531	3120
25944 7590 09/15/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
DINH, KHANH Q				
ART UNIT		PAPER NUMBER		
2451				
MAIL DATE		DELIVERY MODE		
09/15/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/714,876

**Applicant(s)**

MATSUMOTO, HIDETO

**Examiner**

Khanh Q. Dinh

**Art Unit**

2451

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-31 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

1. This is in response to the Amendment and Remarks filed on 5/22/2009. Claims 1-31 are presented for examination.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-6, 8-19, 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhargava et al., US pat. No.7,376,701 in view of Lazaridis et al., US pat. no.6,219,694.

As to claims 1, 21, 22, 23, 27 and 28, Bhargava discloses an electronic device comprising:

a first determination system upon receiving an email message that includes email addresses and contents other than the email addresses, determines whether an e-mail address of an e-mail message transmitted to a mail server (host system 100 fig.1 for providing emails to wireless device 104 fig.1) coincides with the predetermined e-mail address (verifying whether the new email has to be forwarded to the wireless device, see abstract, figs.1-3, col.6 line 19 to col.7 line 3 and col.7 line 38 to col.8 line 55);

a second determination system that determines whether the e-mail message addressed to the predetermined e-mail address is directed to the electronic device to which said second

determination system belongs in accordance with the contents of the e-mail message addressed to the predetermined e-mail address (applying filtering criteria to the email message, see col.8 lines 7-55); and a processing system that executes a procedure corresponding to the e-mail message when said second determination system determines that the e-mail message is directed to the electronic device to which said second determination system belongs (see col.8 line 56 to col.9 line 33).

wherein the plurality of electronic devices are part of a communication system having the mail server (100 fig.1) and the plurality of electronic devices connected with a network (i.e., email messages can be forwarded to multiple wireless devices, see fig.1, col.3 lines 9-24 and col.6 lines 29-63).

Bhargava does not specifically disclose using a predetermined common e-mail address being commonly assigned to and shared by the plurality of electronic devices. However, Lazaridis discloses using a predetermined common e-mail address being commonly assigned to and shared by the plurality of electronic devices (the mobile device and the host system share a common electronic address so that messages generated at either the host system or the mobile data communication device are configured using the common electronic address, see abstract, fig.1 and col.1.7 line 31 to col.1.8 line 55). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Lazaridis's teachings into the computer system of Bhargava for sharing information between network devices because it would have enabled users to continuously redirect certain data items from a network device to other network devices in a communication network.

As to claim 2, Bhargava discloses a destination device information obtaining system that obtains information of a destination device of the e-mail message in accordance with the contents of the e-mail message, said second determination system determining whether the e-mail message is directed to the electronic device to which said second determination system belongs in accordance with whether the information of the destination device designates the electronic device to which said second determination system belongs (see figs.3, 4, col.7 line 43 to col.8 line 55).

As to claim 4, Bhargava discloses that the e-mail message includes a first character string having a predetermined character string followed by a second character string having information designating the destination device (see col.8 line 34 to col.9 line 33).

As to claim 5, Bhargava discloses that the e-mail message has attached data to be processed, wherein each of said plurality of electronic device has data type obtaining system that obtains a data type of the attached data from the contents of the e-mail message, and wherein said second determination system determines whether the e-mail message is directed to the electronic device to which said second determination system belongs based on whether the attached data can be processed by said electronic device (see figs.3, 4, col.7 line 43 to col.8 line 55).

As to claim 6, Bhargava discloses that processing of the attached data including printing of the attached data (see figs.3, 4, col.7 line 43 to col.8 line 55).

As to claim 8, Bhargava discloses an e-mail deleting system that deletes the e-mail message corresponding to the procedure executed by the processing system from the mail server (see fig.5, col.9 line 34 to col.10 line 52).

As to claim 9, Bhargava discloses an e-mail deleting system that deletes the e-mail message corresponding to the procedure executed by the processing system from the mail server predetermine period after the procedure has been executed (see fig.5, col.9 line 34 to col.10 line 52).

As to claim 10, Bhargava discloses that the procedure executed by said processing system includes creation and transmission of a replying e-mail message replying to the e-mail message (see fig.5, col.9 line 34 to col.10 line 52).

As to claim 11, Bhargava discloses that the e-mail message contains a request for a status of the electronic device, and wherein the replying e-mail message contains a status of the electronic device to which the processing system belongs ((see fig.5, col.9 line 34 to col.10 line 52).

As to claim 12, Bhargava discloses that the e-mail message has attached data to be processed, and wherein processing of the attached data including printing of the attached data (see fig.5, col.9 line 34 to col.10 line 52).

Claims 13-19 are rejected for the same reasons set forth in claims 1, 2, 8, 9-12 respectively.

As to claim 24, Bhargava discloses that the communication system is configured such that, when the mail server receives the e-mail message including the information indicative of the designating at least one of the plurality of electronic devices and information indicative of the designated information, a replying e-mail message containing a status in terms of the designated information of the designated at least one of the plurality of electronic devices being transmitted to said computer (see fig.5, col.9 line 34 to col.10 line 52).

As to claim 25, Bhargava discloses a display, a visual interface being provided so as to display a window on said display, the window allowing the operator to select at least one of the plurality of electronic devices sharing the common e-mail address, the visual interface inserting information indicative of the selected at least one of the plurality of electronic devices in the e-mail message (see fig.5, col.7 lines 14-42 and col.9 line 34 to col.10 line 52).

As to claim 26, Bhargava discloses that the window displayed on said display allows the operator to select one or more pieces of information to be obtained from the designated one of the plurality of electronic devices, the visual interface inserting information indicative of the one or more pieces of information to be obtained from the designated at least one of the plurality of electronic devices in the e-mail message (see fig.5, col.7 lines 14-42 and col.9 line 34 to col.10

line 52).

As to claim 29, Bhargava discloses the second determination system determines whether or not the e-mail message should be directed only to the device and not to any other devices (see fig.5, col.7 lines 14-42 and col.9 line 34 to col.10 line 52).

As to claim 30, Bhargava discloses said second determination system determines that the e-mail message is directed to the electronic device to which said second determination system belongs, the processing system directs the e-mail message only to the device, and not to any other devices (see fig.5, col.7 lines 14-42 and col.9 line 34 to col.10 line 52).

As to claim 31, Bhargava discloses the second determination system determines that the e-mail message is not directed to the electronic device, the processing system will not forward the e-mail message to the electronic device (see fig.5, col.7 lines 14-42 and col.9 line 34 to col.10 line 52).

4. Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhargava and Lazaridis and further in view of Taniguchi et al., US pat. No.6,801,962. Bhargava and Lazaridis's teachings still applied as in item 3 above. Bhargava does not specifically disclose the status includes at least one of a remaining amount of toner and a remaining amount of sheet and the attached data is TIFF format data. However, Taniguchi discloses the status includes at least one of a remaining amount of toner and a remaining amount



of sheet and the attached data is TIFF format data (see col.15 line 25 to col.16 line 37). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Taniguchi's teachings into the computer system of Bhargava to process printing data information because it would have enabled users to check the appropriate printing displays and therefore prevented unnecessary outputs in a communication network.

#### **Allowable Subject Matter**

5. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Response to Arguments**

6. Applicant's arguments filed 5/22/2009 have been fully considered but they are not persuasive.

- Applicant asserts that the cited references do not disclose wherein the plurality of electronic devices are part of a communication system having the mail server and the plurality of electronic devices connected with a network.

*Examiner respectfully disagrees. Examiner respectfully point out that Bhargava discloses the plurality of electronic devices are part of a communication system having the mail server (host server 100 fig.1 for processing emails) and the plurality of electronic devices connected with a network (i.e., email messages can be forwarded from*

*the host system to multiple wireless devices, see fig.1, col.3 lines 9-24 and col.6 lines 29-63) as rejected above.*

As a result, cited prior art does disclose an electronic device, as broadly claimed by the Applicants. Applicants clearly have still failed to identify specific claim limitations that would define a clearly patentable distinction over prior art.

### **Conclusion**

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**8.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (571) 272- 3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on (571) 272-3864. The fax phone number for this group is

(571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner for patents

P O Box 1450

Alexandria, VA 22313-1450

/Khanh Dinh/

Primary Examiner, Art Unit 2451